

Inventor: Markus HABERSTROH
Attorney Docket No. HABE3001/JEK
Preliminary Amendment

REMARKS

Acknowledgement of Priority Under 35 USC §119

The examiner is kindly requested to confirm that copies of the certified copy of the priority document has been received in the national stage application from the International Bureau as confirmed in the Notice of Acceptance of Application Under 35 USC 371 and 37 CFR 1.495 mailed September 6, 2004 in this application.

Amendments to Specification

The specification is amended to provide subject matter headings and to otherwise place the written description in better form consistent with U.S. practice.

Amendments to Claims

Claims 6 and 8 have been amended to place them in independent form consistent with the indication by the examiner that the claims recite allowable subject matter. Allowance of claims 6, 8 and 9 is now appropriate and such allowance is respectfully requested.

Claim 1 has been amended to clarify lines 10 and 11 so that the meaning is clear that the sheet material in the sensing region of the checking device is without guidance by a conveyor belt. The amendment is intended to improve the grammar of the original expression of this phrase which originated from a translation of a foreign application.

The amendment to the last line of claim 1 also is intended to clarify the original meaning of the claim language in a manner consistent with the description of the guide plate (8) as described on page 8, lines 6-8 of the written description.

Entry and approval of the amendments is requested.

Claim Rejection – 35 USC §103

It is respectfully submitted that the examiner has not established a *prima facie* case of obviousness with regard to the rejection of claims 1-5, 10, and 11 in view of the primary reference Schirrmeister considered with the secondary reference Mitzel. In support of Applicant's position on this point, the following arguments are advanced for the examiner's consideration.

As a starting point, German patent document DE-A 26 55 580 discussed on page 2 of the written description of this application is acknowledged as disclosing a prior art arrangement whereby sheet material transported via conveyor belt pairs is advanced between opposed inspection devices free of any support by the conveyor but impressed with a reversible wave profile perpendicular to the transport direction for increasing the stiffness of the sheet material while it is moving through the three-flight path. At the conclusion of this discussion, the statement is made: "But it becomes immediately obvious, that the checking of a sheet material deformed in a wave-shaped fashion cannot be carried out in a very reliable and regular fashion." The German document DE-A 26 55 580 corresponds to the cited Schirrmeister patent relied on by the examiner as the primary reference supporting the rejection of claims 1-5, 10 and 11.

Thus, the objective of the present invention is to enable sheet material to be advanced through opposed checking devices unrestrained by a conveyor arrangement and with the sheet material maintained in planar (flat) form. It is recognized that corrugating the sheet material to increase its stiffness will facilitate its advancement through a document checking zone without support of a conveyor, but such corrugation interferes with the inspection process due to the distortion of the surfaces of the document.

Claim 1 recites an exemplary embodiment of the invention which includes, among other structural elements:

- a conveyor belt and transport devices (see 3 in the drawings) opposite thereto arranged to hold and guide sheet material being transported;
- conveyor belt with the help of at least one deflection roller (6) is led away from the transport path before the checking device;
- the sheet material in the sensing region of the checking device is without guidance by a conveyor belt;
- clamping rings (10) disposed coaxial to at least one deflection roller are disposed in the transport direction before the checking device and project over the conveyor belt;
- transport devices (3) lying opposite the conveyor belt cooperate with the clamping rings (10) to grasp sheet material guided in the transport

- path and to guide it between two components of a checking device;
- the sheet material by the cooperation of the transport devices with the clamping rings is led through between the two components of the checking device in plane alignment;
- a guide plate is provided for supporting the advancement of the sheet material between the two components of the checking device and the guide plate includes a zone that combs with the clamping rings.

The examiner contends that Schirrmeister discloses all of the features recited in claim 1 except for the guide plate for supporting the process of advancement of the sheet material between the components of the checking device, while Mitzel provides a teaching of a conveyor belt, transport devices and a guide plate (40) that could be readily adapted to the sheet processing apparatus of Schirrmeister without inventive creativity. As expressed by the examiner, providing the guide plate of Mitzel with the sheet processing apparatus of Schirrmeister would achieve the predictable result of supporting the sheet material as it passes by the checking device through the gap in the conveyor belts.

The examiner overlooks a very important fact in reaching this conclusion. Specifically, providing the guide plate of Mitzel with the apparatus of Schirrmeister would defeat the very objective and purpose of Schirrmeister, which is to support the sheet material by means of corrugations to compensate for the lack of support in the zone between the conveyor belts. The combination of both the corrugating rollers of Schirrmeister with the guide plate of Mitzel in the first place would not be considered by a person of ordinary skill in the art unless the corrugation roller of Schirrmeister were replaced with rollers that simply advanced the sheet material without any corrugation whatsoever, otherwise the use of both corrugating rollers and the flat guide plates of Mitzel would be nonsensical.

It will be apparent to the examiner that the Mitzel plates 40 support sheet material in flat condition in cooperation with the conveyor belt that passes over the guide plates with the sheet material between the conveyor and the guide plates. The sheet material thus is supported on one side by the conveyor and on the other side by the guide plates.

A person of ordinary skill in the art would not be led to introduce such guide plates in the space between the conveyors of the apparatus of Schirrmeister because the problem of the unsupported sheet material has already been solved by Schirrmeister through the use of the

corrugation rollers that impart a corrugation to the sheet material to stiffen it while it is transported through the space between the conveyors, and also because the guide plates of Mitzel must cooperate with a conveyor for holding sheets passing over the guide plate in flat condition.

Notably, neither Schirrmeister nor Mitzel show or teach cooperating clamping rings and transport devices arranged to grasp the sheet material guided in the transport path and to guide the material between the two checking components in an area where there is no conveyor belt, and further wherein the transport devices and the clamping rings are arranged to feed the sheet material in plane alignment, and further using a guide plate provided with a zone that combs with the clamping rings. As noted previously, there are no clamping rings in either Schirrmeister or Mitzel.

It is axiomatic that the showing of obviousness requires the teachings of each reference relied on by the examiner to be compatible and must result in achievement of a structure or process corresponding to the claim that is regarded to be obvious. An attempt to modify the basic reference by means of the teaching of the secondary reference that results in a defeat of the purpose and arrangement of the invention of the basic reference is legally improper and can only be attributed to an attempted use of prohibited hindsight relying on Applicant's own disclosure of the inventive subject matter.

Moreover, assuming for the sake of argument that such a mosaic of prior art could be regarded in a technical sense as within the realm of possibility, if the resultant product still fails to establish novelty and non-obviousness of the claim in question, the attempted combination of teachings fails the primary test of showing lack of novelty and obviousness.

In this instance, for example, none of the prior art considered individually or in combination show clamping rings disposed coaxial with a deflection roller in advance of a checking device and which project over the conveyor belt, elements that are clearly recited in claim 1.

As noted previously, the prior art relied on by the examiner in rejecting the claims individually and collectively fail to show, teach or suggest the combination of the transport devices, clamping rings, and the guide plate having a comb zone with the clamping rings.

None of the prior art considered individually or collectively shows, teaches or

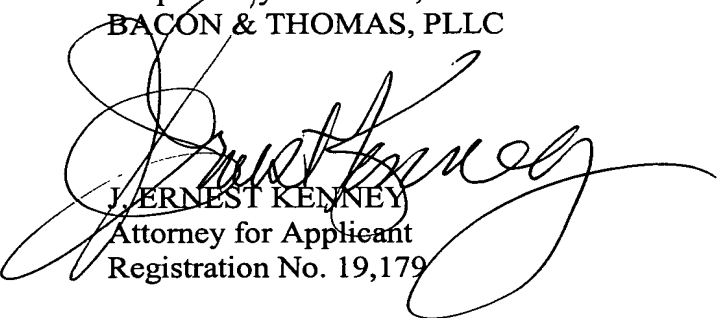
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discloses the aforesaid structural elements in combination with a deflection roller that leads the conveyor belt away from the transport path in advance of the checking device, wherein the deflection roller is mounted coaxial with the recited clamping rings.

The dependent claims 2-5, 7, 10 and 11 further recite elements that patentably distinguish the claims over the cited prior art, assuming for the sake of argument that the rejection establishes at least a *prima facie* case of obviousness.

Given the shortcomings and the examiner's reliance on Schirrmeister and Mitzel in rejecting claims 1-5, 7, 10 and 11 as reciting obvious and therefore unpatentable subject matter, withdrawal of the rejection is appropriate and the same is respectfully requested.

Respectfully submitted,
BACON & THOMAS, PLLC



J. ERNEST KENNEY
Attorney for Applicant
Registration No. 19,179

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Customer Number: 23364
BACON & THOMAS, PLLC
625 Slaters Lane, 4th Floor
Alexandria, Virginia 22314
Telephone: (703) 683-0500
Facsimile: (703) 683-1080